

S/N 09/390,954

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: F. Devon Taylor et al.

Examiner: Michael Cuff

Serial No.: 09/390,954

Group Art Unit: 3627

Filed: September 7, 1999

Docket: 1565.028US1

Title: COMMUNICATION INTERFACE FOR PROVIDING ACCOUNTING
SUPPORT FOR PRINT SERVICES

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicants requests review of the final rejection in the above-identified application. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated below:

REMARKS

This responds to the Office Action mailed on November 17, 2006.

Claims 1-17 are presently pending in this application. Applicants have made no amendments with this response.

§102 Rejection of the Claims

Claims 1-17 were rejected under 35 U.S.C. § 102(b) for anticipation by Bennett et al. (U.S. 5,146,344). It is of course fundamental that in order to sustain an anticipation rejection that each and every step or element in the rejected claims must be taught or suggested in the cited reference.

More specifically, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently in a single reference. *Verdegaal Bros.v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 1051, 1053 (Fed. Cir. 1987). Additionally, "[t]he identical invention must be shown in as complete detail as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claims.

Applicants would like to respectfully reiterate that anticipation is only proper if "[t]he

identical invention must be shown in as complete detail as contained in the . . . claim.”

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ 1913, 1920 (Fed. Cir. 1989).

The Bennett reference is very clearly not directed to a client-server architecture. Bennett is, as Applicants have been asserting for some time now, a self contained print station. The Examiner is attempting to distort the definitions of server, network, and client to make Bennett appear to be a client-server architecture or to at least allegedly read on Applicants claims. The problem is that for a 102 rejection the Examiner has to show the identical invention in as complete detail as is included in the claims. This cannot be done even with the Examiner's generous attempt at distorting the teachings and language of Bennett to conform it to Applicants' independent claims.

Specifically, there is no teaching or suggestion of a teaching in Bennett where a “printer agent and the accounting support services reside on a server within a network.” The “printer agent is also separate and apart from the printer.” In Bennett, no matter how the Examiner interprets the language there is a single device called a print station, which is not network-based and which does not separate a printer agent from a printer and which does not provide a server to house the printer agent.

Bennett does not reference a “network” or a “server” anywhere in its teachings at all. It references memory buses but no “network” reference is made anywhere and no reference whatsoever is made to a “server.” Therefore, the Examiner has extrapolated these teachings to render the claims anticipated. The problem is there is no inherent network as the Examiner alleges, there are components all interfaced together as a single print station device. Applicants disagree with the interpretation and believe that the Appeals' Board will as well. It stretches the imagination and common sense to imply that Bennett includes a network and a server architecture. Applicants do not believe that such inherent interpretation will be sustainable on appeal especially in view of the fact that the rejections are noted as being based on anticipation, which means that Bennett has to show the identical invention in as complete detail as the claims.

This cannot be done with Bennett, where one of ordinary skill in the art would not find a network and would not find a server. Applicants completely and total disagree with the Examiner's conclusion and respectfully request that the review committee withdraw the claims or permit the rejections to stand for appeal purposes.

The Bennett reference is arguably not even relevant to Applicants' invention. Applicants' claims clearly claim a print service that provides driver capabilities independent and separate from the printer itself over a network. Applicants do not believe anyone of ordinary skill in the art would even remotely associate this with Bennett where a single monolithic and self-contained print station is being taught as a single stand alone device. Fine tuned technical interpretations will not change the substance of common sense and that is Bennett has no teaching whatsoever of a network and of a server, which are positively recited and claimed in Applicants' independent claims of record. Moreover, the Examiner has to rely on interpretation and alleged inherent properties of Bennett to even arrive at a network or a server teaching since the entire reference is completely devoid of these terms. By the Examiner's definition of network and server, every computing device includes a network and includes a server; this stretches these terms too far and against what is commonly accepted and understood by those of ordinary skill in the art and it actually renders these terms useless and without meaning if the terms are interpreted in the manner the Examiner proposes.

Applicants completely and respectfully disagree that the Bennett teachings or can even be arguably said to imply a network and a server. Moreover, Applicants respectfully believe that if Bennett can be said to have these teachings then the terms network and server essentially have no meaning or value in the computer arts, which is obviously not the case. The Bennett print station is distinctly not networked and includes no server. Thus, Applicants request that the rejections be withdrawn; the standard for anticipation analysis is more strict than an obviousness rejection and to date the Examiner is asserting an anticipation rejection, which Applicants believe cannot be sustained in view of the Bennett reference.

In fact, even the definitions used by the Examiner demonstrate that there is no network and no server in Bennett. The Examiner's definition indicates that a network is a "group of computers" Figure 2 in Bennett, which the Examiner appears to be relying on, does not include a "group of computers" at best there is one the "controller. The scanner and the printer are not computers. They may be capable of processing but they are not computers. A server was also defined as responding to "commands of a client." There is no client discussed in Bennett anywhere, a client is also a computer. The Examiner appears to be asserting that peripherals, such as printers and scanners are clients and computers; this is not the case these devices are

called peripherals for a reason and they are not called computers by one of ordinary skill in the art. There is no network and no server in Bennett. The rejections should be withdrawn and Applicants respectfully request an indication of the same.

CONCLUSION

Applicants respectfully submit that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at (513) 942-0224 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

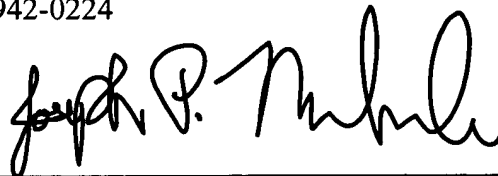
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Date January 17, 2007

By /



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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 17 day of January 2007.

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Name

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